

Appl. No. 09/897,577
Atty. Docket No. 8626
Amdt. dated May 3, 2006
Reply to Office Action of November 3, 2006
Customer No. 27752

REMARKS

Claim Status

Claims 1-36 are pending in the present application. No additional claims fee is believed to be due.

Claim 35 has been rewritten to more specifically characterize that which applicant regards as its invention. Support for this amendment is found at page 13, lines 1-17 of the specification.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

Rejection Under 35 USC §112, First Paragraph

Claim 12 has been rejected under 35 USC §122, Second paragraph as for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Office Action States that the claim is "so indefinite, no art rejection is warranted as substantial guesswork would be involved in determining the scope and content of these claims." Specifically, the Office Actions states that "Claim 12 recites that a vector of talking strengths is equal to "the matrix" times a vector of listening strengths." That "it is not understood what W ("the matrix") and its transpose represent," and that "matrices comprise vectors; therefore, it is not clear how a vector can equal another matrix, which results from the product of 'the matrix' and another vector." Applicant respectfully asserts that this analysis of the Claimed invention is in error.

Applicant directs the Examiner's attention to page 22, lines 16-23, where the value W_{rs} is defined the edge weight from node r to node s , where the edge weight represents the level of messaging activity from User r to User s . In one embodiment of the present invention the value W_{rs} represents a "conversation count" between users r and s . The value W is a matrix of W_{rs} values representing messaging activity (page 23, line 14), and the value W^T represents the transpose of matrix W (page 23, lines 14-20).

With respect to the relationship between matrices and vectors Applicant directs the Examiner to page 23, lines 9-25, where it is stated that the value of u is equal to the

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product of the matrix represented by value W and vector represented by value v (i.e., $u=Wv$), and that conversely the value of v is equal to the product of the transpose of the matrix represented by the value W^T and the vector represented by the value u (i.e., $v=W^T u$).

In light of the above referenced disclosure Applicant respectfully asserts that the meaning and scope of Claim 12 would be clear to one of ordinary skill in the art. Accordingly, Applicant asserts that the rejection of Claim 12 on these grounds is in error and should be withdrawn.

Rejection Under 35 USC §101

The Office Action states that Claims 1-36 are rejected under 35 USC 101 because the claimed inventions are directed to non-statutory matter. The Office Actions states that "a practical application [for the invention] is not clearly set forth in claims 1-36, thereby bringing into doubt the usefulness of the invention." Applicant respectfully asserts that the rejection under 35 USC 101 are in error and should be withdrawn.

35 USC 101 states as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Applicant first highlights that the presently claimed invention is clearly directed to a process, in this case a process for quantitatively analyzing the efficacy of electronic messages for the purpose of improving marketing efficiency. *In re Bergy*, 596 F.2d 952 (C.C.P.A. 1979) has long established that all that is necessary to satisfy the requirements of 35 USC 101 is for the claimed invention to be one of the enumerated class of inventions (i.e., useful process, machine, manufacture, or composition of matter). *Id.* At 960. Applicant asserts that this alone should be sufficient to overcome any rejection under 35 USC 101, as the present invention is clearly a process.

In ruling in the matter of *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1526 (Fed. Cir. 1994), the Federal Circuit held that the determination of patentability should not be based exclusively on the presence or absence of physicality, but on the practical utility of the claimed invention. In the matter of *In re Alappat*, 33F.3d 1526 (Fed. Cir. 1994) the

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Federal Circuit clearly held that in order for an invention to have practical application it shall provide a "useful, concrete and tangible result." *Id.* At 1544.

The presently claimed invention is directed to a method for analyzing electronic messages directed between individuals to quantitatively assess the relative communication capabilities of such individuals. In particular, the methods of the present invention are employed in determining a quantitative value referred to as a "communication strength." (See Specification at page 6, line 19 to page 7, line 14, and Abstract). Applicant, therefore, respectfully asserts that the ability to quantitatively assess the efficacy of communications and identify effective communicators undoubtedly demonstrates such a useful, concrete and tangible result.

The present invention is clearly directed towards a process, thereby satisfying the requirements for patentability set forth in *In re Bergy*, 596 F.2d 952 (C.C.P.A. 1979). Moreover, the present invention clearly demonstrates practical utility in the manner set forth in *In re Alappat*, 33F.3d 1526 (Fed. Cir. 1994) and *State Street Bank & Trust Co. v. Signature Financial Group*, 149 F.3d 1526 (Fed. Cir. 1994). Accordingly, Applicant respectfully asserts that the present invention has more than satisfied the requirements for utility under 35 USC 101 and continued rejection on this basis would be in error and should be withdrawn.

Rejection Under 35 USC §103(a) Over Altschuler et al. (US Patent No. 6,151,585) in view of Hotzman et al. (US Patent Application No. 2002/0062368)

Claims 1-11, 13-15 and 18-36 have been rejected under 35 USC §103(a) as being unpatentable over Altschuler et al. (US Patent No. 6,151,585) in view of Hotzman et al. (US Patent Application No. 2002/0062368). Applicants respectfully traverse this rejection as the reference combination of Altschuler and Hotzman does not establish a *prima facie* case of obviousness because it does not contain a suggestion or motivation to be combined or modified to achieve Applicant's claimed invention. Therefore, Applicants' assert that the claimed invention is unobvious and that the rejection should be withdrawn.

A *prima facie* case of obviousness must be based on facts, "cold hard facts." *In re Freed*, 165 USPQ 570, 571-72 (C.C.P.A. 1970). When the rejection is not supported by facts, it cannot stand. *Ex parte Saceman*, 27 USPQ2d 1472, 1474 (B.P.A.I. 1993). As is well settled, an Examiner cannot establish obviousness by locating references which

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describe various aspects of a patent applicant's invention without also providing evidence of the motivating force which would *impel* one skilled in the art to do what the patent applicant has done. *Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993). Applicant's respectfully assert that the present office action fails to provide such reason or rationale why one would be motivated, let alone impelled, to combine the Altschuler reference with the Hotzman reference in the manner suggested. Thus, the rejection fails to set forth the required facts and reasoning required to support a *prima facie* case of obviousness.

The Examiner has the burden of establishing (1) that there is suggestion or motivation to combine the references relied upon, and (2) that the references, when so combined, contain the requisite suggestion and motivation which would have led one to combine the particular disclosure relied upon and to make a composition as claimed. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The Examiner is therefore required to demonstrate *where* in Altschuler or Hotzman there is a suggestion which would have "strongly motivated" one to make the systems and methods of the present invention as claimed. *Ex parte Graselli*, 231 USPQ 393, 394 (Bd. App. 1986). The type of motivation which would have "*impelled*" one to do so (*Ex parte Levengood*, 28 USPQ2d 1300, 1301-02 (BPAI 1993)), and the type of suggestion that the changes "*should*" be made. *Ex parte Markowitz*, 143 USPQ 303, 305 (Bd. App. 1964). Here, the Examiner has not provided sufficient evidence to support a *prima facie* case of obviousness for why one would have modified Altschuler with Hotzman to achieve Applicant's claimed invention.

Neither Altschuler nor Hotzman contain any suggestion or motivation to be combined in the manner suggested. As recognized by the Office Action, Altschuler expressly states that gathering 'explicit' information to identify 'influential rumormongers' is difficult," and that the present invention uses "resource usage log data to infer data of a directed graph from which 'influential rumormongers' may be determined." (See Altschuler, Col. 5, lines 17-20). Applicant respectfully asserts that this passage clearly teaches away from Applicants' present invention, and that such teachings do not provide an expectation of success for utilizing "explicit" information to arrive at Applicant's claimed invention. Because the Office Action has not identified any

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suggestion, reason, or other motivation, including suggestion of desirability, for why one would have been led to combine Altschuler with Hotzman, the rejection is in error and should be withdrawn.

Rejection Under 35 USC §103(a) Over Altschuler et al. (US Patent No. 6,151,585) in view of Hotzman et al. (US Patent Application No. 2002/0062368) in further view of Nakagawa et al. (US Patent No. 6,414,691)

Claims 16 and 17 have been rejected under 35 USC §103(a) as being unpatentable over Altschuler et al. (US Patent No. 6,151,585) in view of Hotzman et al. (US Patent Application No. 2002/0062368) in further view of Nakagawa et al. (US Patent No. 6,414,691). Applicant respectfully asserts that this objection in error and should be withdrawn.

Neither Altschuler, Hotzman, nor Nakagawa contain any suggestion or motivation to be combined in the manner suggested. Because the Office Action has not identified any suggestion, reason, or other motivation, including suggestion of desirability, for why one would have been led to combine Altschuler, Hotzman, or Nakagawa, the rejection is in error and should be withdrawn.

Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 35 USC §112, Second Paragraph, 35 USC §101, 35 USC §103(a). Early and favorable action in the case is respectfully requested.

This response represents an earnest effort to place the application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-36 is respectfully requested.

Respectfully submitted,

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